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Remarks

Claims Applicants have canceled claims 32-3, 42 and 45-60 and 72 without prejudice. Claims 42 and 45-59 were previously withdrawn from consideration pursuant to 37 CFR 1.142(b) as being drawn to the nonelected Group II claims. Applicants reserve the right to prosecute any of these claims in continuation or divisional applications.

Applicants have amended the independent claims 1 and 77 in accordance with the telephone conversations of Friday, April 15, 2005 and Monday, April 18, 2005 wherein it was indicated that the subject matter of amended claims 1 and 77 was patentable over the art of record.

Specification

The disclosure has been objected to because the amendment to the Specification on page 22, line 24, recites "about 76 :m to about 305 :m" which should be --about 76 :m to about 305 :m--.

Applicants have amended the appropriate paragraph.

Claim Objections

35 U.S.C. §112, first paragraph

Claim 77 has been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Office Action asserts that there is no support in the original Specification for maintaining the magnetic field until the magnetic layer cools.

Applicants have amended claim 77. The language to which the examiner has objected has been removed. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

Obviousness-type Double Patenting

Claims 1 has been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9, 12, 14, 15 and 27 of copending Application No. 10/274189. A terminal disclaimer is enclosed herewith.

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35 U.S.C. §103

Claims 1-17, 22-32, 35, 38-41, 60, 72 and 75 have been rejected under 35 U.S.C. §103(a) as being obvious over Bielek et al. (US Patent NO. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586).

Claim 1 has been amended in accordance with our teleconference and proposed claim amendments faxed on Friday, April 15, 2005 and discussed Monday, April 18, 2005. Claim 1 now recites specific substrates not suggested for use in the assembly of Bielek et al. Silverschotz et al. do not suggest the range of polymer nor the range of magnetic material in a hot melt magnetic composition as recited in claim 1 of the present application. The remaining references do not suggest magnetic assemblies nor magnetic compositions of the type recited in the method of claim 1.

Bielek et al. describe the use of a polymer carrier film only and describe sufficient adhesion of the example having Vitel® 3350 resin to the film, but describe the example as not adhering sufficiently well to a wide variety of receiving surfaces to which the composites of the invention may be applied. This is presumptively the best mode of Bielek et al. Silverschotz disclose paper but the range of polymer and ferromagnetic material are different than the embodiment of claim 1 of the present application.

A person skilled in the art would not expect that direct application of such a composition as above would produce adequate adhesion to substrates other than those disclosed therein in view of Bielek et al.'s statements at col. 2, last paragraph to the top of col. 3.

Claims 2-17, 22-32, 35 and 38-41 depend from claim 1 and are patentable for at least the reasons that claim 1 is patentable. Claims 60 and 72 have been canceled. Claim 75 has been amended to depend from claim 1 and is patentable for at least the reasons that claim 1 is patentable.

Applicants respectfully request withdrawal of the rejection of claims 1-17, 22-32, 35, 38-41, 60, 72 and 75 under 35 U.S.C. §103(a) as being obvious over Bielek et al. (US Patent NO. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent

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No. 2,944,586).

Claims 1-10, 13-17, 22-32, 35, 38-41, 72 and 78 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No., 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) as applied to claims above, and further in view of Marshall et al. (US Patent No. 5,503,891).

Claim 1 has been amended as discussed above. Claims 2-10, 13-17, 22-32, 35 and 38-41 depend from claim 1 and are patentable for at least the reasons that claim 1 is patentable.

Claim 72 has been canceled.

Claim 78 has been amended to depend from claim 77.

Claim 77 has been amended in accordance with the first proposed amended discussed which was faxed to the examiner on Friday, April 15, 2005 and discussed on Monday, April 18, 2005. Support for the amendment can be found at least from Fig. 1 and the description for Fig. 1 found on page 16. This is not intended to exclude embodiments where the printable substrate layer is coated, lacquered or has some other type of treatment, for example.

Claim 77 is patentable over the art of record for the reasons discussed. Bielek et al. describes an assembly having a carrier film, a first ferromagnetic adhesive layer, a second adhesive layer and a release liner. Combining the secondary references with Bielek et al. does not lead one of skill in the art to the embodiment of amended claim 77.

Applicants respectfully request withdrawal of the rejection of claims 1-10, 13-17, 22-32, 35, 38-41, 72 and 78 under 35 U.S.C. §103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No., 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) as applied to claims above, and further in view of Marshall et al. (US Patent No. 5,503,891).

Claims 5 and 77 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No., 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view

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of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Rippingale et al. (US Patent No. 5,114,517).

Claim 1, from which claim 5 depends, has been amended as discussed above.

Claim 77 has been amended as discussed above.

Applicants believe claims 1 and 77 to be patentable over the art of record as discussed on Monday, April 18, 2005.

Applicants respectfully request withdrawal of the rejection of claims 5 and 77 under 35 U.S.C. §103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No., 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Rippingale et al. (US Patent No. 5,114,517).

Claims 17 and 19-21 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No., 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Sawa (US Patent No. 4,022,701).

Claim 1, from which claims 17 and 19-21 has been amended. Applicants believe claim 1 as amended to be patentable over the art of record. Bielek et al. do not suggest substrates of the type recited in amended claim 1. Claims 17 and 19-21 are patentable for at least the reasons that claim 1 is patentable.

Applicants respectfully request withdrawal of the rejection of claims 17 and 19-21 under 35 U.S.C. §103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No., 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Sawa (US Patent No. 4,022,701).

Claims 33, 34, 36 and 37 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US

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Patent No. 5,869,148) as further taken with Wade (US Patent No., 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Charley (US Patent NO. 6,153,279).

Claims 33, 34, 36 and 37 depend from claim 1 which has been amended as discussed above.

Applicants respectfully request withdrawal of the rejection of claims 33, 34, 36 and 37 under 35 U.S.C. §103(a) as being unpatentable over Bielek et al. (US Patent No. 6,387,485) in view of Silverschotz et al. (US Patent No. 5,869,148) as further taken with Wade (US Patent No., 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and optionally further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Charley (US Patent NO. 6,153,279).

Claims 79 and 80 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Bielek et al. (US Patent NO. 6,387,485) as taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Gregory (US Patent No. 4,941,935), Christel (US Patent No. 5,676,791) and/or Thompson (US Patent No. 4,455,184).

Claims 79 and 80 depend from claim 1 which has been amended. Claims 79 and 80 are patentable for at least the reasons that claim 1 is patentable.

Applicants respectfully request withdrawal of the rejection of claims 79 and 80 under 35 U.S.C. §103(a) as being unpatentable over Bielek et al. (US Patent NO. 6,387,485) as taken with Wade (US Patent No. 3,470,055), Mueller (US Patent No. 2,690,206), and/or Yanulis (US Patent No. 2,944,586) and further in view of Marshall et al. (US Patent No. 5,503,891) as applied to claim 1 above, and further in view of Gregory (US Patent No. 4,941,935), Christel (US Patent No. 5,676,791) and/or Thompson (US Patent No. 4,455,184).

Claim 77 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US Patent NO. 5,869,148) and further in view of Rippingale et al. (US Patent No. 5,114,517).

The method of claim 77 has been amended to recite a hot melt magnetic

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composition having a range of polymer binder and a range of magnetic material not suggested by Silverschotz et al. Combining Rippingale et al. with Silverschotz et al. does not lead one of skill in the art to a method of forming a magnetic assembly which employs a magnetic hot melt composition as recited in amended claim 77.

Applicants respectfully request withdrawal of the rejection of claim 77 under 35 U.S.C. §103(a) as being unpatentable over Silverschotz et al. (US Patent NO. 5,869,148) and further in view of Rippingale et al. (US Patent No. 5,114,517).

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CONCLUSION

Claims 1-41, 75 and 77-80 are pending in the application. Applicants reserve the right to prosecute the canceled claims in divisional/continuation applications. Applicants respectfully request reconsideration and an early allowance of the claims as presented. Should any issues remain, the attorney of record may be reached at (952)563-3011.

Respectfully submitted,

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